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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,247	01/22/2004	Hasan Nejad	M4065.0513/P513-A	2010
24998	7590	03/06/2006	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			PRENTY, MARK V	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	
			2822	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

11A

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/761,247	Applicant(s) NEJAD ET AL.	
	Examiner MARK PRENTY	Art Unit 2822	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 53.
Claim(s) rejected: 41-52 and 54-60.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Mark Prenty
Mark V. Prenty
Primary Examiner

CONTINUATION SHEET OF ADVISORY ACTION (Item 11)

The request for reconsideration has been considered but does NOT place the application in condition for allowance because of the reasons of record (see the Office Action mailed November 21, 2005) and because the applicants' arguments are incorrect as explained below.

As a preliminary matter, the examiner respectfully notes that the applicants have not squarely addressed the thrust of said Office Action (i.e., "Given that Ning discloses that 'various' techniques 'such as' PVD and CVD may be used to form its bottom metal stack, and also discloses electroplating deposition as an alternative to PVD and CVD, Ning discloses that its bottom metal stack, and hence its bottom sense layer, can be electroplated").

The applicants' allegation: "The Office Action continues to assert that the bottom metal stack of Ning could be formed by electroplating," continues to be incorrect. Again, the Office Action does not merely assert that Ning's bottom metal stack "could be formed by electroplating." Again, the maintained rejection actually asserts: "Ning discloses...an electroplated bottom sense layer (i.e., magnetic stack 222's bottom metal stack, which can be formed by electroplating – see column 6, lines 59-62 together with column 6, lines 35-38)." In other words, the maintained rejection asserts and demonstrates that Ning discloses that its bottom sense layer can be formed by electroplating (for example).

The applicants correctly remark: "the bottom metal stack of Ning is referred to as being deposited by techniques such as physical vapor deposition (PVD), evaporation,

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ion sputtering, and chemical vapor deposition,” (emphasis added), but the applicant’s arguments completely ignore both the cited “such as” language and the examiner’s “Given that Ning discloses that ‘various’ techniques ‘such as’ PVD and CVD may be used to form its bottom metal stack, and also discloses electroplating deposition as an alternative to PVD and CVD, Ning discloses that its bottom metal stack, and hence its bottom sense layer, can be electroplated,” explanation.

The applicants’ argument: “As mentioned in Applicants’ previous Response, the description in Ning being relied upon in regard to electroplating relates to forming a metal cap layer 220, and not to the formation of an electroplated bottom layer as claimed,” is incorrect and ignores the explanation of the rejection, which relies upon Ning’s column 6, lines 59-62, together with column 6, lines 35-38. Specifically, the significance of Ning’s column 6, lines 35-38, disclosure that “First metal cap layer 220 may be deposited by PVD, CVD, or may be electroless-plated and selectively deposited,” is not that metal cap layer 220 may be formed by electroplating but that electroplating is an alternative to PVD and CVD. Accordingly, when Ning later discloses at column 6, lines 59-62, that “Various techniques such as” PVD and CVD may be used to form its bottom metal stack, Ning on the whole has disclosed that the bottom metal stack can also be formed by electroplating.

The applicants’ remark: “Applicants respectfully submit that the metal cap layer of Ning is not equivalent to, or the same as the electroplated bottom layer of the claimed invention,” is not really on point. Again, the significance of Ning’s metal cap layer disclosure is that it discloses electroplating as an alternative to PVD and CVD.

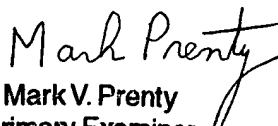
The applicants' allegation: "Ning refers to forming the magnetic stack only by PVD, evaporation, ion sputtering, and CVD," (emphasis added), is incorrect, as evidenced by Ning's column 6, lines 59-62, disclosure: "Various techniques such as physical vapor deposition (PVD), evaporation, ion sputtering, and chemical vapor deposition (CVD) may be used to deposit the magnetic layers of bottom metal stack" (emphasis added).

The applicants' allegation: "No mention is made to forming the magnetic stack using an electroplating method," is without merit and simply ignores the explanation of the rejection. The issue is not whether Ning makes "mention" of forming the magnetic stack using an electroplating method but whether Ning on the whole discloses forming the magnetic stack using an electroplating method. Ning clearly does disclose forming the magnetic stack using an electroplating method at column 6, lines 59-62, together with column 6, lines 35-38, as explained above.

The applicants' allegation: Ning was clearly aware of the electroplating process based on its reference to the method in relation to the metal cap layer. The Office Action cannot simply stretch the teachings of the cited reference to assert that it refers forming an electroplated bottom layer," is without merit. The Office Action has not "stretched" Ning's teachings; the applicants have simply ignored them taken together. Indeed, the examiner respectfully submits that the applicants' arguments in this regard are somewhat analogous to incorrectly arguing a 35 USC 103 rejection by attacking the combined references individually rather than as a whole.

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Registered practitioners can telephone the examiner at (571) 272-1843. Any voicemail message left for the examiner must include the name and registration number of the registered practitioner calling, and the Application/Control (Serial) Number. Technology Center 2800's general telephone number is (571) 272-2800.


Mark V. Prenty
Primary Examiner